

**REMARKS**

In an Office Action mailed September 17, 2003, the Examiner: (1) rejected claim 16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, (2) rejected claims 1, 2, 5, 11, 13-15, 16, 17, 18, and 20 under 35 U.S.C. §103(a) as being unpatenable over U.S. Patent No. 6,450,204 (Itzhaky) in view of U.S. Patent No. 3,588,552 (Schafft), and (3) objected to each of claims 3, 4, 6-10, 12, and 19 as being dependent upon a rejected base claim, but otherwise allowable, if rewritten in independent form.

Applicants have amended claim 16 and accordingly respectfully request the Examiner to withdraw the rejection of this claim.

Applicants have also amended claim 10 to correct a minor informality.

With respect to the rejection of claims 1, 2, 5, 11, 13-15, 16, 17, 18, and 20 under 35 U.S.C. §103(a) as being unpatentable over Itzhaky in view of Schafft, Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. M.P.E.P. § 2143. Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. Id. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art, not in Applicant's disclosure. M.P.E.P. § 706.02(j) (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

Applicants respectfully submit that there is no *prima facie* case of obviousness because one of ordinary skill in the art would not have had any motivation to combine the two references in the manner suggested by the Examiner. The Examiner states that "[i]t would have obvious to one of ordinary skill in the art at the time the invention was made to modify the piezoelectric valve of Itzhaky by changing the clamping connection (7a) of the bending transducer to a cylindrical connection as taught by Schafft in order to reduce the stress on the bender where the bender is connected to the housing." (September 17, 2003 Office Action, page 3, second paragraph). Applicants respectfully note that aside from this conclusory allegation, the Examiner has not provided any evidence of a suggestion or motivation to combine the two references and thus the two cited references have been improperly combined in the Office Action.

Schafft is directed to achieving a device having an idealized knife's edge configuration illustrated in Figure 6. (col. 1, ll. 46-55; col. 3, ll. 55-59). Schafft recognizes that "[t]he embodiment shown in Fig. 6, however, is difficult to attain ...." (col. 3, ll. 8-9). In order to achieve this idealized configuration, Schafft proposes a groove formed by surfaces 14 and 15 into a metallic ring 13. (col. 2, ll. 27-31). According to Schafft, circular piezoelectric disc 10 is then placed in the groove formed by surfaces 14 and 15. (col. 1, ll. 64-75). That groove forms a rectangular retaining area. Thus, Schafft does not provide any suggestion or motivation to modify the piezoelectric valve of Itzhaky by changing the clamping connection (7a) of the bending transducer to a cylindrical connection as alleged by the Examiner.

Indeed, Schafft does not correct the deficiencies in the teachings of Itzhaky. As discussed above, Schafft does not teach a bending transducer having a cylindrical connection as alleged by the Examiner. Thus, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 2, 5, 11, 13-15, 16, 17, 18, and 20 under 35 U.S.C. § 103(a) based on the purported combination of Itzhaky and Schafft.

The Office Action contains a number of statements reflecting characterizations of the claims and/or the related art. Regardless of whether any such statements are addressed above, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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